

Docket No. F-7309

Ser. No. 10/067,123

REMARKS

Claims 1-5, 7-9, and 11-14 are now pending in this application. Claims 1-9, 11 and 12 are rejected. Claim 6 is cancelled herein. New claims 13 and 14 are added. Claims 1, 3, 4, 8, 9, 11 and 12 are amended herein to clarify the invention. Other formal matters are attended to that were not addressed by the Examiner and accordingly are considered unrelated to substantive patentability issues.

FIRST ACTION NOT TO BE MADE FINAL

Applicant and applicant's attorney appreciate Examiner Brockett returning applicant's attorney's call regarding submission of the present amendment. In the ensuing conversation, it was explained that the claims would be amended to recite a feature, discussed below, wherein a base for a pickoff throw is selected by moving a pointing device or mouse, and the action of a pickoff throw rather than a pitch is subsequently selected by a button operation. It was explained that this matter was not previously in the claims and it was anticipated that entry of the present amendment after final rejection would be refused. The Examiner indicated that if the amendment was filed with an RCE as the present amendment is, the first office action in response to the present amendment would not be made final.

Docket No. F-7309

Ser. No. 10/067,123

CLAIM REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103

Claims 1-5 and 7-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Okitsu. Claims 6, 11 and 12 are rejected as obvious over Okitsu in view of EA Games "Triple Play 200" under 35 U.S.C. §103(a). The applicant herein respectfully traverses these rejections.

"Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference. ... In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. U.S. International Trade Commission*, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir.

Docket No. F-7309

Ser. No. 10/067,123

1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection". It is respectfully submitted that the cited references fail to disclose at least the following features and elements of the present invention and the required suggestion to make modifications arriving at such features and elements.

Claims 1, 8, 9 and 11 are now amended to include the subject matter of claim 6 relating to the moving operation of the mouse being used to designate a base to which a pickoff throw is to be made. In addition to the subject matter of claim 6, the claims now reflect that a base selection for the pickoff throw is made by moving the pointing device, or mouse depending on the claim language, followed by a button operation selecting the pickoff throw as the pitching action. Likewise, the instruction for pitching is made by moving the pointing device, or mouse depending on the claim language, followed by a button operation selecting pitching as the pitching action.

As used in the claims and specification, "pitching action" merely refers to the actions that an actual pitcher in baseball can take when on the mound. Such actions include a pickoff throw or a pitch to the batter. In the real game of baseball, the pitcher seeks to hide his intentions as to whether a pickoff throw or a pitch is to be made until the last possible moment in order to catch a base runner off guard. In the presently claimed game, the claimed feature allows a player to move the mouse, an action that can be seen by a competitor, and then select at the

Docket No. F-7309


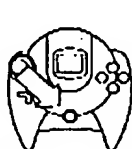
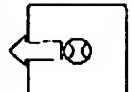

Ser. No. 10/067,123

last instant whether a pitch or a pickoff throw is made by operating a button. Thus, the suspense and realism of real baseball is transferred to the claimed pointing device operation.

Okitsu, in Fig. 7, discloses the changing of the pitching type according to the inclination of a joystick-like element (an analogous cross key: line 65: col. 7). In addition, Okitsu, in Fig. 3, discloses a selection between the pitching to a home base and the picking-off throw ("feint throw") to one of 1st, 2nd, & 3rd bases in response to the predetermined button operations.

Fig. 7 of Okitsu (USP6394894)

FIG.7

PITCH TYPE	RIGHT-HANDED PITCHER	INPUTTING
CURVE/ SLOW CURVE		
SHOOTER		

Docket No. F-7309

Ser. No. 10/067,123

With respect to claims 6, 11 and 12, in addition to Okitsu, the Examiner referred to Triple Play 2000 for teaching the use of a mouse in a baseball game operation. However, the claims as now amended provide features not found in either of the applied references. The amended claims reflect features of an example referenced in the step 3 of Fig. 2 wherein the pitching type and the pick-off base are selected (please refer to a first paragraph on page 17 of the specification). In fact, the movement of the mouse in top view is taken as an instruction of the selection of the pitching type (eight divided regions A, B, C, ..., H: see Fig. 4) or an instruction of the base to be picked off (left, top, & right regions corresponding to 3rd base, 2nd base, and 1st base: see Fig. 15). Whether the movement thereof is taken as the pitching type selection or the pick-off base selection will be determined in the latter button operation of the mouse. It is understood that the embodiment disclosed uses a mouse, but unless specifically stated in the claims, any pointing device is sufficient. In this latter button operation of the mouse, one is, for instance, pressing a left button only and the other is pressing both left & right buttons. In short, when the mouse is moved to a certain direction, at this very moment, a game device or the other player does not know whether that movement is meant to be a selection of pitching type or a selection of

Docket No. F-7309

Ser. No. 10/067,123

base to be picked off as the subsequent button operation of the mouse makes a decision.

For instance, in the step 3, let's say, the mouse is moved to left side (to a region G in Fig. 3, equivalent to a region S in Fig. 15), what does this mean? Does this movement mean an instruction of the pitching type to be "slider" or picking off 3rd base? The subsequent step regarding the operations of the buttons on the mouse will give the answer. In this subsequent step, if the left button of the mouse is depressed, then it indicates that the pitching type is "slider". If on the other hand, the both left and right buttons of the mouse are pressed, then it indicates the 3rd base is to be picked off. As mentioned, how the buttons of the mouse are operated subsequently after the mouse movement operation changes the instructions corresponding to the same mouse movement. Such a feature is not disclosed or suggested in Okitsu. Neither is this feature is disclosed in Triple Play 2000.

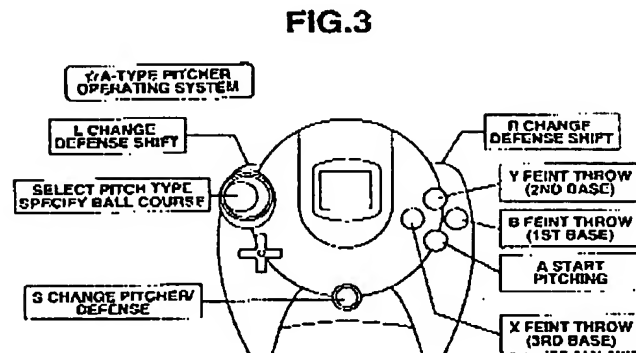
Okitsu, as shown in Fig. 3, discloses an operating member (which looks like a joystick that can be inclined any direction from top view) that is to be used for selecting a specific pitch type and is not used for selecting a base to be picked off. For the selection of the base to be picked off, there are three buttons (B; Y; X, corresponding to 1st base, 2nd base, and 3rd base) provided on the right hand side of a game pad. A fourth button (A start pitching) is provided in the lower portion

Docket No. F-7309

Ser. No. 10/067,123

of those four buttons (X; Y; A; B) on the right side of the game pad. Thus, Okitsu does not select a base by pointing device movement.

Okitsu Fig. 3



Triple Play 2000 mentions that "Move the mouse to the base you want to throw to and off the ball goes." However, Triple Play 2000 does not mention that the selection of the pitching type also can be done by the movement of the mouse.

Docket No. F-7309

Ser. No. 10/067,123

Neither does it suggest that the movement of the mouse is determined in the latter operation of the buttons of the mouse as now recited in the amended claims.

Claim 12 recites more specific features that include the movement of the mouse to left, top, and right direction as a selection of a pitching type when in the subsequent step a specific button operation is carried out and the movement of the mouse to left, top, and right direction is received as a base to which a pick-off ball is thrown when in the subsequent step another specific button operation is carried out. Such details are not disclosed by the references.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of the pending claims and their allowance are respectfully requested.

Additionally, in the above descriptions, examples of the specification are referred to merely to confer examples of implementations of the claimed features and are not intended to limit the language of the claims.

Dependent claims 13 and 14 are added and are submitted as patentable over the cited art of record and are submitted as patentable based on the subject matter cited therein in addition to the subject matter of their respective base claims.

Docket No. I-7309

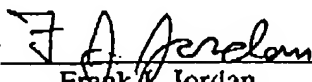
Scr. No. 10/067,123

REQUEST FOR CONTINUED EXAMINATION FILED HEREWITH

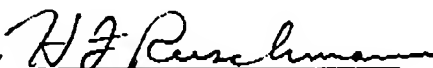
A request for continued examination is be filed along with this amendment to secure entry thereof and includes a request for a one month extension of time.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By 
Frank V. Jordan
Reg. No. 20,456
Attorney for Applicants

by and,

By 
Herbert F. Ruschmann
Reg. No. 35,341
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Request for Continued Examination.